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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,536	01/12/2004	Simon Robert Walmsley	PEA25US	9210
24011 7590 09/20/2007 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER PARTHASARATHY, PRAMILA	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/754,536	WALMSLEY, SIMON ROBERT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Pramila Parthasarathy	2136	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to the communication 09/22/2006. Preliminary amendments were filed. Claims 1 – 17 are currently pending.

#### ***Information Disclosure Statement***

2. An initialed and dated copy of Applicant's IDS form 1449 is attached to the Office action.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 17 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 – 18 and 20 of copending application 10/727,158. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of

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claims 1 and 5 correspond to the claims of 1 – 18 and 20 of the copending application, except in the instant claims the elements “receiving software data and generating the first digest ... using one of the keys” is referred in the copending claims as “receiving the message generated by the first integrated circuit ... and encrypting key”. Copending claims are broader than the corresponding the instant application claims which encompasses “integrated circuit configured to run a boot program that prevents unverified software from subsequently being loaded onto, or run by, the integrated circuit” as copending claims recite “the supervisor mode is available to a program upon verification of that program by a boot program of the integrated circuit”. Thus copending application claims anticipates the instant claims.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting (*In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993)*).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: Claim 1 is a method claim with “a step of including ....”. Replace “a step of including “ with “a step of: including”. Claim 1 recites “customised”. Replace with “customized”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 – 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims limitations recited in 1 – 17 do not have any support in the specification other than the summary of the invention wherein, the summary contains exact claim language, i.e., summary of the invention is a copy of all the claim limitations.

6. Claims 1 – 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims limitations recited in 1 – 17 do not have any functional or descriptive support in the specification.

Applicant is requested to exactly point out wherein the specification any support can be found for the limitations that are recited in Claims 1 – 17, in response to this office action.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 17 are rejected under 35 U.S.C. 102(e) as being anticipated by

Sormunen et al. (US Publication 2003/0014663).

8. As per Claim 1, Sormunen teaches “loading an intermediate program onto the integrated circuit, the intermediate program being customised for a particular one or more of a plurality of potential integrated circuits that, when run on the processor, enables loading or running of code on only the particular one or more integrated circuits” (paragraph [0032 – 0034]).

9. As per Claim 5, Sormunen teaches, “An integrated circuit configured to run a boot program that prevents unverified software from subsequently being loaded onto, or run by, the integrated circuit” (paragraph [0032 – 0034]).

10. As per Claim 2, Sormunen teaches “wherein the intermediate program enables the loading or running of unverified code on only the particular one or more integrated circuits” (paragraph [0033 – 0034]).

11. As per Claim 4, Sormunen teaches “wherein the intermediate program includes an intermediate boot key, such that the intermediate program enables loading or running of the code only when the code is verified in accordance with the intermediate boot key” (paragraph [0033 – 0034]).

12. As per Claim 3, Sormunen teaches “wherein the intermediate program enables the loading or running of the code only when the code includes data



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indicative of the particular one or more integrated circuits” (paragraph [0040 – 0041]).

**13.** As per Claims 6 and 12, Sormunen teaches “receive software data and a digital signature of the software data generate a first digest from the software data; and compare the first digest against a second digest obtained via the digital signature that accompanied the received software data; wherein the program is considered valid when the first and second digests match” (paragraph [0032 – 0036]).

**14.** As per Claim 7, Sormunen teaches “wherein one or both of the digests were generated using a SHA1 function” (paragraph [0047]).

**15.** As per Claims 8 and 14, Sormunen teaches, “wherein the boot program contains a plurality of keys, and one of the keys is selected for use in generating the first digest, the key being selected in accordance with a selection criterion” (paragraph [0044 – 0047]).

**16.** As per Claim 13, Sormunen teaches, “wherein the encryption function is RSA” (paragraph [0045 – 0047]).

**17.** As per Claim 9 and 15, Sormunen teaches “the selection criterion is time-based, a particular one of the keys being selected depending on the time the selection is made” (paragraph [0044 – 0047]).

**18.** As per Claims 10 and 16, Sormunen teaches, “wherein the selection criteria relates to a physical arrangement or configuration of the integrated circuit” (paragraph [0044 – 0047]).

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19. As per Claims 11 and 17, Sormunen teaches “wherein the physical arrangement or configuration includes one or more of the following: one or more pads wired to a reference voltage or to ground; one or more fuses, one or more of which has been blown; or the contents of non-volatile memory” (paragraph [0032 – 0034]).

### ***Conclusion***

Examiner’s Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

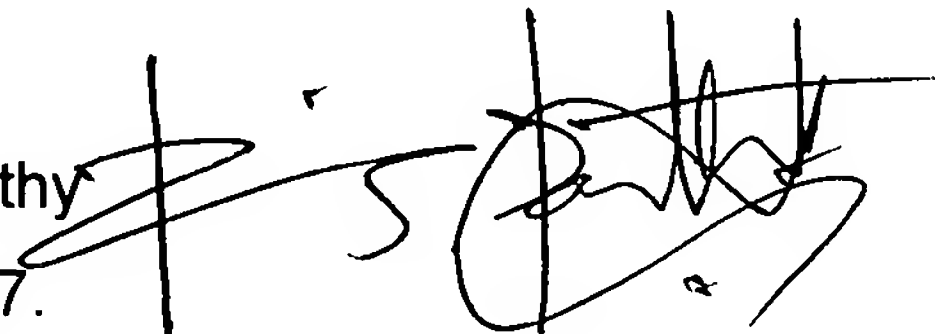


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-232-4195. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy  
September 06, 2007.

A handwritten signature in black ink, appearing to be 'Pramila Parthasarathy', written over a horizontal line.